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09/653,095	08/31/2000	Heath B. Clarke	ELIBER.001A	4070

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EXAMINER
RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/653,095	Applicant(s) CLARKE, HEATH B.	
	Examiner Rob Rhode	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 August 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3 & 6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 3, 6, 7 and 25 are rejected under 35 U.S.C. 102(e) as being unpatentable over Sanford et al (US Patent 6,256,028 B1).

Regarding Claim I and related Claim 25, Sanford teaches a method and system of providing access to information relating to a plurality of products using a cascading commerce menu, comprising - providing a first level menu listing a first set of product categories (Abstract and Figure 7); detecting a position of a cursor over a first product category listed in said first set of product categories (Col 7, lines 11 – 13 and Figure 7); and providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position (Col 7, lines 11 – 13 and Figure 7).

Regarding Claim 2, Sanford teaches a method, wherein said cascading menu is stored on a client computer (Col 5, lines 57 – 67 and Figure 5).

Regarding Claim 3, Sanford teaches a method, wherein at least one of said listed first set of product categories provides a link over the Internet to a commerce site (Col 6, lines 66 – 67 and Figure 7).

Regarding Claim 6, Sanford teaches a method as defined, wherein the cascading menu is dynamically generated from text, and where the text is stored on a client computer (Col 2, lines 38 – 42).

Regarding Claim 7, Sanford teaches a method, wherein the dynamically generated cascading menu is updated, further comprising - receiving an indication of a version of the text stored on the client computer (Col 2, lines 35 – 44); transmitting changes to be applied to the text stored on the client computer (Col 2, lines 35 – 44); updating the text stored on the client computer using the transmitted changes (Col 2, lines 35 – 44); and dynamically generating the cascading menu from the updated text (Col 2, lines 35 – 51 and Figure 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 5, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (US Patent 6,256,028 B1) in view of Axaopoulos (US Patent 6,286,022 B1).

Sanford discloses and teaches a method – including related portions of Claim 14 addressed and referenced previously in this office action of providing access to information relating to a plurality of products using a cascading commerce menu, comprising - providing a first level menu listing a first set of product categories; detecting a position of a cursor over a first product category listed in said first set of product categories; and providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position. In addition, Sanford discloses and teaches a method, wherein the dynamically generated cascading menu is updated, further comprising - receiving an indication of a version of the text stored on the client computer; transmitting changes to be applied to the text stored on the client computer; updating the text stored

on the client computer using the transmitted changes; and dynamically generating the cascading menu from the updated text.

On the other hand, Sanford does not specifically disclose and teach a method further comprising automatically generating a search string based on said first category and said first subcategory – as well as providing a display of a plurality of products from multiple vendors, where the plurality correspond to the search string. Nor does Sanford specifically disclose and teach further including ranking providers based on an aggregate price of an item available from the providers wherein the item corresponds to the first product category and the first product subcategory, the method comprising - receiving a first item price for said item from a first provider; receiving a first additional cost associated with providing the item by said first provider to a first consumer; receiving a second item price for said item from a second provider; receiving a second additional cost associated with providing the item by said second provider to said first consumer; and ranking said first provider and said second provider based on at least said first item price, said second item price, said first additional cost, and said second additional cost.

However and regarding Claim 4, Axaopoulos teaches a method, further comprising automatically generating a search string based on said first category and said first subcategory (Col 3, lines 16 – 30 and Col 11, 32 – 67)

Regarding Claim 5, Axaopoulos teaches a method, further comprising providing a display of a plurality of products from multiple vendors, where the plurality corresponds to the search string (Figure 22).

Regarding Claim 8, Axaopoulos teaches a method, further including ranking providers based on an aggregate price of an item available from the providers wherein the item corresponds to the first product category and the first product subcategory, the method comprising - receiving a first item price for said item from a first provider (Figure 22); receiving a first additional cost associated with providing the item by said first provider to a first consumer (Figure 22); receiving a second item price for said item from a second provider (Figure 22); receiving a second additional cost associated with providing the item by said second provider to said first consumer (Figure 22); and ranking said first provider and said second provider based on at least said first item price, said second item price, said first additional cost, and said second additional cost (Figure 22).

Regarding Claim 14, Axaopoulos teaches a method of automatically generating a search request based at least in part on said customer selection of said relatively narrower product category (Col 3, lines 16 - 32); and providing the customer with information on products related to said selected relatively narrower product category at least partly in response to said search request (Col 17, lines 1 –3 and Figure 22).

It would have been obvious by one of ordinary skill in the art at the time of the invention to have provided the method of Sanford with the method of Axaopoulos to have provided the capability of automatically generating a search string based on said first Category and said first subcategory as well as providing a display of a plurality of products from multiple vendors, where the plurality correspond to the search string – in order to ease the burden on the shopper to search the web for items highlighted/selected and being provided with ranked, multiple bidders and thereby increase their level of satisfaction as well as significantly increasing the including probability that they will return in the future to the web site.

Claims 9 – 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (US Patent 6, 256,028 B1) in view of Axaopoulos (US Patent 6,286,002 B1) and further in view of Shkedy (US Patent 6,260,024).

The combination of Sanford and Axaopoulos discloses and teaches (Sanford teachings addressed and referenced above) a method of providing the capability of automatically generating a search string based on said first category and said first subcategory – as well as providing a display of a plurality of products from multiple vendors, where the plurality correspond to the search string. Additionally, the combination of Sanford and Axaopoulos specifically disclose and teach the ranking of providers based on an aggregate price of an item available from the providers wherein the item corresponds to the first product category and the first product subcategory, the method comprising -

receiving a first item price for said item from a first provider; receiving a first additional cost associated with providing the item by said first provider to a first consumer; receiving a second item price for said item from a second provider; receiving a second additional cost associated with providing the item by said second provider to said first consumer; and ranking said first provider and said second provider based on at least said first item price, said second item price, said first additional cost, and said second additional cost.

On the other hand, the combination of Sanford and Axaopoulos does not specifically disclose and teach, wherein said first additional cost is a shipping, tax and insurance cost associated with the provision of said item from said first provider, and said second additional cost are these cost associated with the provision of said item from said second provider - as well as providing an auction capability.

However and regarding Claim 9, Shkedy teaches a method wherein said first additional cost is a shipping cost associated with the provision of said item from said first provider, and said second additional cost is a shipping cost associated with the provision of said item from said second provider (Col 17, lines 55 – 59).

Regarding Claim 10, Shkedy teaches a method, wherein said first additional cost is a tax associated with the provision of said item from said first provider, and said second

additional cost is a tax associated with the provision of said item from said second provider (Col 17, 55 – 59).

Regarding Claim 11, Shkedy teaches a method, wherein said first additional cost is an insurance cost associated with the provision of said item from said first provider, and said second additional cost is an insurance cost associated with the provision of said item from said second provider (Col 17, lines 55 – 59).

Regarding Claim 12 and related Claim 19, Shkedy teaches a method, wherein an addition of said second item price and said second additional cost is lower than an addition of said first item price and said first additional cost, and where said second provider is ranked higher than said first provider (Col 7, lines 13 – 20).

Regarding Claim 13 and related Claim 20, Shkedy teaches a method, further comprising receiving a bid from said first provider to lower at least one of said item price and said first additional cost to thereby improve the first provider's ranking (Col 26, lines 46 – 64).

It would have been obvious at the time of the invention to have provided the combination of Sanford and Axaopoulos with the method of Shkedy to have provided the capability wherein said first additional cost is a shipping, tax and insurance cost associated with the provision of said item from said first provider, and said second

additional cost are these cost associated with the provision of said item from said second provider and providing an auction capability – in order to provide an even more robust capability in shopping for, and providing detailed information from several providers on requested products. As a result, this method will significantly ease the online shoppers efforts and increase their satisfaction with the web site and its stickyness features. Moreover, these capabilities will significantly increase the probability that the shopper will return to the web site more often for future shopping and buying, which will increase total sales for the site.

Claims 15 – 18 and 22 - 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (US Patent 6, 256,028 B1) in view of Axaopoulos (US Patent 6,286,002 B1) and further in view of Scroggie et al (US Patent 6,185,541 B1).

The disclosures and teachings of the combination of Sanford and Axaopoulos were previously addressed and referenced.

The combination of Sanford and Axaopoulos on the other hand do not disclose and teach a method further comprising providing the customer a reward or credit at least partly in response to using the cascading commerce menu as well as in response to customer purchasing a product – which can include an advertisement.

However and regarding Claim 15, Scroggie teaches a method, further comprising providing the customer a reward at least partly in response to using the cascading commerce menu (Col 3, lines 12 – 14)

Regarding Claim 16, Scroggie teaches a method, wherein the reward is a credit (Col 3, lines 12 – 14).

Regarding Claim 17, Scroggie teaches a method, further comprising providing the customer a reward in response to the customer purchasing at least one product associated with the selected relatively narrower product category (Col 3, lines 14 – 21).

Regarding Claim 18, Scroggie teaches a method, further comprising providing an advertisement on at least one of said first level menu and said cascading second level menu (Col 7, line 62).

Regarding Claim 22, Scroggie teaches a method, further comprising causing the display of an amount of the reward associated with a selection of a first subset of product categories (Col 7, lines 52 – 55).

Regarding Claim 23, Scroggie teaches a method, further comprising causing the display of the total rewards earned by the customer (Col 7, lines 52 – 55).

Regarding Claim 24, Scroggie does not teach a method, further comprising - providing a referral award in response to the customer causing others to download said cascading menus; and causing the display of the referral reward amounts earned by the customer. Official Notice is taken that both the inventive concept and the advantage of providing a referral award method for customers are well known and expected in the art. Thus it would have been obvious to have provided the customer a referral method in order to not only increase customer satisfaction but also as importantly add additional shoppers to the site as result of this incentive.

It would have been obvious to one of ordinary skill in the art at the time of the intention to have provided the combination of Sanford and Axaopoulos with the method of Scroggie to enable the capability of providing the customer a reward or credit at least partly in response to using the cascading commerce menu as well as in response to customer purchasing a product – which can include an advertisement. In that regard, the on line shopper is incented to continue using the web site more frequently for purchases in order to capture and use these cost reduction benefits – and too increasing the satisfaction of the customer as well as increasing their frequency of use in shopping.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (US Patent 6,256,028 B1) in view of Scroggie (US Patent 6,185,541 B1).

Previously in this office action, the details regarding what Sanford discloses and teaches were fully addressed and referenced – which also apply to the first four steps of Claim 21.

However, Sanford does not specifically disclose and teach providing a reward to the customer at least partly in response to the customer's selection of said first subset of product categories.

Regarding Claim 21, Scroggie does disclose and teach a method of providing a reward to the customer at least partly in response to the customer's selection of said first subset of product categories (Col 3, lines 12 – 14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Sanford with the method of Scroggie to enable the capability of providing a reward to the customer at least partly in response to the customer's selection of said first subset of product categories – in order to provide the customer a reward or credit at least partly in response to using the cascading commerce menu as well as in response to customer purchasing a product – which can include an advertisement. In that regard, the on line shopper is incented to continue using the web site more frequently for purchases in order to capture and use these cost reduction benefits – and too increasing the satisfaction of the customer as well as increasing their frequency of use for shopping.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is Bezos et al (US Patent 6,029,141), Barnett et al (US Patent 6,336,099 B1) and Cater (US Patent 5,926,798) which all address online shopping, search, incentives and referrals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7658 for regular communications and 703.308.3687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER

March 5, 2003

GLYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.